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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/125,114	08/18/1998	IAN ASHLEY PRICE	P8129-8004	7439

6449 7590 09/08/2003

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WASHINGTON, DC 20005

EXAMINER
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JIANG, SHAOJIA A

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 09/08/2003

41

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/125,114

Applicant(s)

PRICE, IAN ASHLEY

Examiner

Shaojia A Jiang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 21 January 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-26 and 30-37 is/are pending in the application.
- 4a) Of the above claim(s) 11-15, 20-25 and 32-37 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10, 16-19, 26, 30 and 31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

### **DETAILED ACTION**

This Office Action is a response to Applicant's amendment and response filed on January 21, 2003 in Paper No. 37 wherein claims 1-10, 16-19, 26, 30 and 31 have been amended. Currently, claims 1-26 and 30-37 are pending in this application.

As indicated in the previous Office Action October 18, 2002, claims 11-15, 20-25, and 32-37 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim.

Claims 1-10, 16-19, 26, 30 and 31 are examined on the merits herein.

Applicant's amendment filed on January 21, 2003 in Paper No. 37 with respect to the rejection of claims 1-10, 16-19, 26, 30 and 31 made under 35 U.S.C. 112 second paragraph for the use of the indefinite expressions of record stated in the Office Action dated October 18, 2002 have been fully considered and found persuasive to remove the rejection. Therefore, the said rejection is withdrawn.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-10, 16-19, 26, 30 and 31 as amended now in Paper No. 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Geyer et al. (5,380,535) and Elger et al. (4,844,907) for reasons of record stated in the Office Action dated October 18, 2002.

Adding the recitations "adapted to disintegrate quickly in the gastro-interestinal tract" in claim 1 (line 2) and claim 16 (line 3) and "is obtained by compressing said ... " in claim 1 (line 8-9) and claim 16 (line 8-9) do not render the claimed compositions nonobvious over the prior art because the recitation "adapted to disintegrate quickly in the gastro-interestinal tract" is considered to be intended use of the composition herein and/or an inherent property.

Applicant is requested to note that it is well settled that "intended use" of a composition or product, e.g., "adapted to disintegrate quickly in the gastro-interestinal tract", will not further limit claims drawn to a composition or product. See, e.g., *Ex parte Masham*, 2 USPQ2d 1647 (1987) and *In re Hack* 114, USPQ 161.

Moreover, it has been well settled that recitation of an inherent property of a composition, e.g., disintegrate quickly in the gastro-interestinal tract, will not further limit claims drawn to a composition.

Applicant is further requested to note that "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product

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was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted). The product-by-process claim was rejected because the end product. See MPEP 2113. Thus, the recitation "is obtained by compressing said ..." in claim 1 (line 8-9) and claim 16 (line 8-9) is not considered a limitation of the composition herein.

Applicant's remarks filed on January 21, 2003 in Paper No. 37 with respect to this rejection made under 35 U.S.C. 103(a) of record in the previous Office Action have been fully considered but are not deemed persuasive as to the nonobviousness of the claimed invention over the prior art for the following reasons.

In contrast to Applicant's assertion that Greyer teaches away from the instant invention, as discussed in the previous Office Action, Greyer clearly teaches that the composition therein comprises sodium bicarbonate in 0.1 to about 20% weight (see col.6 lines 16-28 and Example 3 and 5). The formulations of Ibuprofen in 0.1-75% or 0.5-40% weight in compressed tablet form comprising the instant ingredients are also clearly taught at col.8 lines 1-36 and Example 3 and 5 in Greyer.

Therefore, motivation to combine the teachings of the prior art cited herein to make the present invention is seen. The claimed invention is clearly obvious in view of the prior art.

For the above stated reasons, said claims are properly rejected under 35 U.S.C. 103(a). Therefore, said rejection is adhered to.

Claims 1-10, 30 and 31 as amended now in Paper No. 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Geyer et al. (5,380,535) and Gregpry et al. (5,262,179) for reasons of record stated in the Office Action dated October 18, 2002.

As discussed above, adding the recitations "adapted to disintegrate quickly in the gastro-interestinal tract" in claim 1 (line 2) and claim 16 (line 3) and "is obtained by compressing said ..." in claim 1 (line 8-9) and claim 16 (line 8-9) do not render the claimed compositions nonobvious over the prior art.

Applicant's remarks filed on January 21, 2003 in Paper No. 37 with respect to this rejection made under 35 U.S.C. 103(a) of record in the previous Office Action have been fully considered but are not deemed persuasive as to the nonobviousness of the claimed invention over the prior art for the following reasons.

As discussed above, Greyer clearly teaches that the composition therein comprises sodium bicarbonate in 0.1 to about 20% weight (see col.6 lines 16-28 and Example 3 and 5). The formulations of Ibuprofen in 0.1-75% or 0.5-40% weight in compressed tablet form comprising the instant ingredients are also clearly taught at col.8 lines 1-36 and Example 3 and 5 in Greyer.

Therefore, motivation to combine the teachings of the prior art cited herein to make the present invention is seen. The claimed invention is clearly obvious in view of the prior art.

For the above stated reasons, said claims are properly rejected under 35 U.S.C. 103(a). Therefore, said rejection is adhered to.

In view of the rejections to the pending claims set forth above, no claims are allowed.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

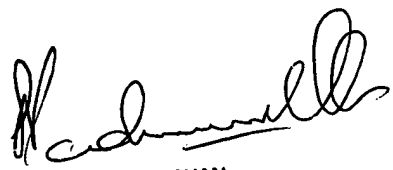
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Jiang, whose telephone number is (703) 305-1008. The examiner can normally be reached on Monday-Friday from 9:00 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreenivasan Padmanabhan, Ph.D., can be reached on (703) 305-1877. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-1235.

S. Anna Jiang, Ph.D.  
Patent Examiner, AU 1617  
September 2, 2003

  
SREENI PADMANABHAN  
PRIMARY EXAMINER  
9/4/03